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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

JP

Office Action Summary

Application No.

10/642,934

Applicant(s)

NGUYEN ET AL.

Examiner

Benjamin W. Lee

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 May 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-37 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>05/02/2007</u> . | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

1. The amendment filed 05/02/2007 has been entered. Claims 1 and 2-37 are pending in this application. Claim 2 is cancelled. Claims 1, 14, and 25 have been amended. Claims 35-37 are new.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 1, 3-13, and 37 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Re claim 1: The claim is directed toward a method, which falls under the four statutory categories of invention (i.e. process, machine, manufacture, and composition of matter). However, the process disclosed in the claim includes the judicial exception of an abstract idea (a method for configuring the software of a gaming machine). No physical transformation is present to establish a practical application of the abstract idea. Furthermore, the process disclosed in the claim does not produce a useful, concrete, and tangible result. "Loading the gaming software" is useful and concrete, but is not tangible. Loading gaming software may cause other events that produce a tangible result, but the step of loading gaming software does

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not. The step of loading gaming software would not be perceivable by a user of the method and thus is not tangible. Therefore, the claim is directed toward non-statutory subject matter.

Re claims 3-13: The claims are dependent on claim 1 and do not disclose any further method steps that correct the deficiency. Therefore, the claims are directed toward non-statutory subject matter.

Re claim 37: The claim is directed toward a computer-readable medium storing computer program code operable to perform the method of claim 1. The computer-readable medium storing computer program code is considered a statutory invention (a manufacture). However, the computer program does not result in a physical transformation or useful, concrete, and tangible result as discussed in the rejection of claim 1 above. Therefore, the claim is non-statutory because the computer program stored on the computer-readable medium is non-functional descriptive material since the overall apparatus (computer program stored on the computer-readable medium) does not result in a physical transformation or useful, concrete, and tangible result.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1, 3, 4, 7-9, 13, and 37 are rejected under 35 U.S.C. 102(b) as being anticipated by Kelly et al. (US 2002/0010025 A1, hereinafter Kelly).

Re claims 1 and 37: Kelly discloses a computer-implemented method/computer-readable medium with program code comprising receiving data/login information indicative of a gaming unit on which a player has chosen to play a selected one or more games in a tournament (see Fig. 3; ¶ [0040], lines 9-11; ¶ [0088]; ¶ [0118]), determining whether the chosen gaming unit is configured/updated for playing the one or more games in the tournament (see Fig. 9; ¶ [0092]), obtaining gaming software/executing an installer for the one or more games when it is determined that the chosen gaming unit is not configured for playing the one or more games in a tournament (see Fig. 9; ¶ [0092]), wherein the gaming software can effectively configure the chosen gaming unit for playing the one or more games in a tournament (see Fig. 9; ¶ [0092]), and loading the gaming software/executing the game for the one or more games after the player has chosen the gaming unit when it is determined that the chosen gaming unit is not configured for playing the one or more games in the tournament (see Fig. 9; ¶ [0092]), thereby effectively configuring the chosen gaming machine for participation in the tournament play of the one or more games and enabling the player to use the chosen gaming machine to play the one or more games in the tournament (see abstract).

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Re claim 3: The teachings of Kelly as applied to claim 1 have been discussed above.

Kelly et al. further discloses transmitting the gaming software to the gaming unit via a network (see Figs. 1 and 4; ¶ [0092]).

Re claim 4: The teachings of Kelly as applied to claim 1 have been discussed above.

Kelly et al. further discloses loading the gaming software from a diskette, CD-ROM, or portable memory device (see ¶ [0036]).

Re claim 7: The teachings of Kelly as applied to claim 1 have been discussed above.

Kelly et al. further discloses the gaming software comprises an executable file (see ¶ [0092]).

Re claim 8: The teachings of Kelly as applied to claim 1 have been discussed above.

Kelly et al. further discloses the gaming software is a configuration file (see ¶ [0050]; ¶ [0051]).

Re claim 9: The teachings of Kelly as applied to claims 1, 7, and 8 have been discussed

above. Executable files and configuration files may be considered data files.

Re claim 13: The teachings of Kelly as applied to claim 1 have been discussed above.

Kelly et al. further discloses generating data indicative of a plurality of respective value payouts to be awarded to the plurality of winning players, wherein the plurality of respective value payouts comprises a plurality of shares of a jackpot (see ¶ [0119]; ¶ [0120]).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

8. Claims 14, 15, 18-20, 24, 25, 28-30, and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kelly.

Re claims 14, 15, and 25: The teachings of Kelly as applied to claim 1 have been discussed above. Kelly further discloses a tournament server/prize database server 104/servers 112 operable to perform the gaming method recited in claim 1 and comprising a network interface operatively coupled to a network 100 (see Fig. 1; ¶ [0028]).

However, Kelly fails to explicitly disclose the tournament server comprises a controller operatively coupled to the network interface, the controller comprising a processor and a memory operatively coupled to the processor.

It was well known in the art at the time the invention was made to use processors and memory in servers.

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Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use a processor and memory in the tournament server in order to allow the server to communicate with the gaming unit.

Re claim 18-20: The teachings of Kelly as applied to claims 7-9 and 14 have been discussed above.

Re claim 24: The teachings of Kelly as applied to claims 13 and 14 have been discussed above.

Re claims 28-30: The teachings of Kelly as applied to claims 7-9 and 25 have been discussed above.

Re claim 34: The teachings of Kelly as applied to claims 25 and 13 have been discussed above.

9. Claims 5, 16, and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kelly in view of Okamoto (US 5,489,103).

Re claim 5: The teachings of Kelly as applied to claim 1 have been discussed above.

However, Kelly fails to disclose or fairly suggest confirming that the gaming software was loaded to the gaming unit successfully.

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Okamoto teaches a method for transferring game or karaoke data from a host facility to a plurality of terminals. At step S1150 the host facility is notified that the transmission was completed following the completion of a data transfer (see Fig. 6; col. 6, lines 32-42).

Therefore, in view of Okamoto, it would have been obvious to one of ordinary skill in the art at the time the invention was made to add the step of confirming a successful software load to the system of Kelly in order to provide a more reliable and easier to troubleshoot data transfer.

Re claims 16 and 26: The teachings of Kelly as applied to claims 14 and 25 have been discussed above. The teachings of Kelly as modified by Okamoto as applied to claim 5 have been discussed above.

10. Claims 6, 17, and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kelly in view of Schneier et al. (US 5,768,382, hereinafter Schneier).

Re claim 6: The teachings of Kelly as applied to claim 1 have been discussed above.

However, Kelly fails to disclose or fairly suggest authenticating the gaming software after loading the gaming software to the gaming unit.

Schneier teaches authenticating game software by generating a hash value of the game software (see Figs. 6A and 6B; col. 18, line 31 - col. 19, line 19).

Therefore, in view of Schneier, it would have been obvious to one of ordinary skill in the art at the time the invention was made to add the step of authenticating the game software after loading in order to provide a more reliable and secure system.

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Re claims 17 and 27: The teachings of Kelly as applied to claims 14 and 25 have been discussed above. The teachings of Kelly as modified by Schneier as applied to claim 6 have been discussed above.

11. Claims 10, 21, and 31 rejected under 35 U.S.C. 103(a) as being unpatentable over Kelly in view of Morrow et al. (US 2003/0064771, hereinafter Morrow).

Re claim 10: The teachings of Kelly as applied to claim 1 have been discussed above.

However, Kelly fails to disclose or fairly suggest the gaming software comprises a pay table.

Morrow teaches a reconfigurable gaming machine wherein the game on the gaming machine may be changed by transferring new game software via a network. Morrow discloses that new pay tables may be downloaded (see ¶ [0012]).

Therefore, in view of Morrow, it would have been obvious to one of ordinary skill in the art at the time the invention was made to add the step of transferring a new pay table along with corresponding game software in order to provide a greater variety of game to players.

Re claims 21 and 31: The teachings of Kelly as applied to claims 14 and 25 have been discussed above. The teachings of Kelly as modified by Morrow as applied to claim 10 have been discussed above.

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12. Claims 11, 12, 22, 23, 32, and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kelly in view of Halliburton et al. (US 2002/0052229 A1, hereinafter Halliburton).

Re claims 11 and 12: The teachings of Kelly as applied to claim 1 have been discussed above.

However, Kelly fails to disclose or fairly suggest randomly or pseudo-randomly generating a plurality of seeds for a random number generator to be implemented by the gaming unit.

Halliburton teaches a solitaire game played over the Internet that uses a server/client architecture. The sequence of cards for each player is determined by using a randomly generated seed to locally generate a random sequence of cards (see ¶ [0045], lines 19-23).

Therefore, in view of Halliburton, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have the server randomly generate a plurality of seeds and send them to game playing clients for generating random outcomes in order to provide more effective random number generation since the seed is generated independently of the gaming unit.

Re claims 22, 23, 32, and 33: The teachings of Kelly as applied to claims 14 and 25 have been discussed above. The teachings of Kelly as modified by Halliburton as applied to claims 11 and 12 have been discussed above.

Response to Arguments

13. Applicant's arguments filed 05/02/2007 have been fully considered but they are not persuasive.

The rejections of the claims using the Kelly reference have been discussed above. The rejection of claim 1 is summarized as follows: Kelly teaches a system and method for tournament play in a network system. A player logs into the system (an indication of which gaming unit a player has chosen) and the gaming machine is checked to see if the software needs an update (determine whether the chosen gaming unit is configured for playing). If the software needs an update, an installer is downloaded and run (obtain gaming software for configuring the gaming machine for play in a tournament). Then the game is executed (loading gaming software for configuring the gaming machine for play in a tournament). The examiner notes that the claim limitation "one or more games in a tournament" has not narrowed the scope of the claimed subject matter because "one or more" still includes one game (as was previously claimed) and tournaments inherently have multiple games that must be played to arrive at one winner (e.g. round-robin tournament or a bracket tournament).

Conclusion

14. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Benjamin W. Lee whose telephone number is 571-270-1346. The examiner can normally be reached on Mon - Fri (8:30 - 5:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Pezzuto can be reached on 571-272-6996. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Ronald Laneau
RONALD LANEAU
PRIMARY EXAMINER

7/23/07

BWL

Benjamin W. Lee
July 12, 2007